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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,151	10/12/2000	John J. Sie	19281-000600US	8606
20350 7590 08/20/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
BROWN, RUEBEN M				
ART UNIT		PAPER NUMBER		
2424				
MAIL DATE		DELIVERY MODE		
08/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/687,151

Applicant(s)

SIE ET AL.

Examiner

REUBEN M. BROWN

Art Unit

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13, 21, 22, 24, 25 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 21, 22, 24, 25 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the 103 rejection of the claims have been fully considered, but they are not persuasive. As pointed out in the 112, 1st paragraph rejection below, applicant does not appear to have support the claimed '*singlecast media*'. It is noted that the term does not appear in the specification, nor does examiner find support for the claimed subject matter, as presented in the Remarks. Thus, the combination of Proehl & Inoue still reads on the present invention, as best understood, by the examiner.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 9 & 31 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. *'the first and second portions are received with different media types chosen from a group consisting of multicast media or a singlecast media'*, critical or essential to the practice of the invention, included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

In numerous passages of the specification, it is cited that the first and second portions of the NVOD program may be received over different communication medium, see page 20, lines 15-20; page 21, lines 5-10. Even though these passages teach that the first portion may be broadcast (which apparently corresponds with the claimed '*multicast media*'), examiner does not find any support for the additionally claimed '*singlecast media*'. It is noted that term 'singlecast', does not appear in the specification.

To the contrary, even though applicant argues in pages 9-10 of the Remarks that the invention overcomes prior art of record, since the second portion is received via a singlecast media communication, applicant's specification expressly discloses that the second portion of the NVOD could be received from a NVOD download cycle, i.e., the NVOD channels 948, 952, 956 or channels 928, 932, 936, apparently already in use, (see page 20, lines 28-32; page 22, lines 1-4 & page 23, lines 1-2), which appears to also read on a multicast distribution.

The specification (page 20, lines 14-20; page 21, lines 4-10) also discusses that the remaining portion could be received from a broadband connection, however, a broadband connection does not necessarily read on the claimed '*singlecast media*'.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6-13, 21-22, 25 & 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proehl, (U.S. Pat # 6,990,676), in view of Inoue, (U.S. Pat # 5,884,141).

Considering claim 1 & 31-34, the claimed method for receiving a program by a user location that is sent from a content distributor, comprising:

'receiving the program at the user location as a first linearly scheduled program, which can be viewed on a first channel', is met by the disclosure of Proehl that a user selects regular broadcast programming for display on the TV screen, see Abstract; Fig. 13A; Fig. 13B; col. 14, lines 26-67.

As for the claimed, *'processing and storing a first portion of the program at the user location',* and *'detecting a user request for the program after storage of the first portion and receiving a second portion of the program in response to the user request',* Proehl discusses that

graphics images such as still shots from the instant program or short video clips related to the program, etc. may be downloaded and stored on the hard drive of the user's terminal equipment, Abstract; col. 15, lines 1-18. Proehl goes on to discuss that if the user selects a linearly scheduled broadcast program that is currently being broadcast, that the system presents the user with the instant broadcast program. However, these graphics images, (such as short video clips) will be presented to the user when a linearly scheduled broadcast program is selected that is scheduled to be broadcast in the future from the current date/time, which is different from the recited claims.

Nevertheless, Inoue provides a teaching of, receiving and storing a lead-in segment of a movie/program Fig. 1; col. 8, lines 35-47. In particular, Inoue teaches that when a viewer chooses certain NVOD movies, the first segment of the instant NVOD movie is read out from a buffer at the viewer site, while the remaining portion of the instant movie is being transmitted. Therefore the combination of Proehl & Inoue meets the claimed subject matter.

The combination of Proehl & Inoue provides for the system to download short clips, such lead-ins for different programming services, such as linearly scheduled broadcast programs, including NVOD programs. Once a customer selects a particular broadcast program, then a lead-in segment is initially played from the user's terminal equipment, with the remaining portion coming from the regular broadcast. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Proehl with the feature of presenting the first portion of a program from downloaded segments, at least for the desirable advantage of overcoming any delay/hiatuS created by time consumed in any downloading/transmission

processing, at the beginning of scheduled broadcast, such as NVOD, as taught by Inoue, col. 2, lines 25-40.

As for the amended claimed feature of: *'wherein the first portion is at least one eighth of the program'*, Proehl only discusses images as "short clips", without examples of the duration, whereas Inoue discusses that the lead-in segment should be at least as long as the broadcasting interval between channels carrying the program, see col. 8, lines 59-65. Official Notice is taken that at the time the invention was made, access to larger memory units/cache was well known in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify the combination of Proehl & Inoue with the well-known technology of expanded memory capacity, which enables longer durations of the lead-in segments to be stored on the receiver, for example such as an hour or more, at least for the desirable improvement of expanding the time available for the system to transmit the rest of the program to the consumer.

The first portion being at the beginning of the program, reads on Inoue, col. 9, lines 1-15.

'receiving a second portion in response to detecting the user request, wherein the second portion is received as a linearly scheduled program in a different channel from the first, and the first and second portion are NVOD' also reads on the disclosure of Inoue, which teaches that the remaining portion if NVOD is transmitted after the subscriber requests, and that the remaining portions may be transmitted on different NVOD channels, CH1-CH7.

'storing the second portion at the user location', reads on Inoue col. 3, lines 59-63; col. 7, lines 31-48.

The additionally claimed is analyzed as best understood, in view of the above 112, 1st paragraph rejection. Regarding the additionally claimed, *'the first and second portions are received with different media types chosen from a group consisting of multicast media or a singlecast media'*, the linearly scheduled programming of Proehl (col. 14, lines 35-60) meets claimed *'multicast media'* and the downloaded lead-in segment of Inoue (col. 11, lines 10-25) meets the claimed *'singlecast media'*.

Considering claims 2 & 11, if the viewer's home equipment has downloaded and stored a lead-in segment of the movie that the viewer has just selected, then the lead-in segment is retrieved from the receiver and begins to be displayed for the viewer; see Inoue, Abstract; col. 8, lines 45-67.

Considering claims 3 & 12, the instant claims recite that a *'first time associated with playing the first portion is equal to or greater than a second time associated with receiving or transmitting a second or plurality of portions'*, reads on the disclosure that the duration should be at least as long at the time between intervals, col. 8, lines 55-67.

Considering claim 4, the claimed subject matter reads on the operation of the remote controller 14 of Proehl, which used infrared technology, col. 9, lines 52-64.

Considering claim 13, the programs in Inoue that include a lead-in segment read on the recited programs consisting of a first and second portion; col. 8, lines 12-67. Thus, the combination of Proehl & Inoue meets the claimed subject matter.

Considering claim 6, the claimed set-top box reads on the integrated receiver 12 of Proehl, Fig. 1; col. 4, lines 15-67 & col. 5- col. 7 and the receiver of Inoue, Fig. 1.

Considering claim 7, the claimed mass storage device reads on the HDD 228 of Proehl, col. 6, lines 1-35; col. 15, lines 1-18. Inoue stores the pre-storage NVOD on a hard disk, col. 9, lines 1-15.

Considering claim 8, the claimed feature of *'determining a subset of programs from a linear schedule of programs and dividing each of the subset of programs into a respective first and second respective portion'* reads on the server in Inoue transmitting the lead-in segments for certain movies, col. 8, lines 48-65. It is disclosed that lead-ins are only generated for "different programs", which reads on *'determining a subset of programs'*. The additionally claimed feature of transmitting a plurality of the respective first portions to the user location is also met by the above-cited disclosure of Inoue.

Considering claim 9, Subject matter that corresponds with limitations discussed in claim 1, are likewise treated. Inoue teaches that a certain of the programs at a central station 10, have

lead-in segments, which in combination with Proehl, reads on the claimed *'determining a linear schedule of content programs, wherein each content comprises a first segment and a second segment'*; see col. 2, lines 1-8, since Inoue is directed to NVOD with linearly scheduled programming, see Figs 2A; 2B; 3A; 3B. 4A; 4B.

The additional step of storing a second set of segments remotely from user location reads on the server in Inoue, which inherently stores NVOD moves before they are transmitted. The additionally claimed features of, *'transmitting and storing a first set of segments to the user location, and transmitting one of the second set of segments to the user location, after a request from the user'* is met by col. 3, lines 1-30; col. 4, lines 12-35 & Fig. 5.

As for the amended claimed feature: *'wherein the first segment is at least fifteen minutes'*, represents a logical extension of the subject matter found in claim 1, and is likewise analyzed.

Considering claim 10, the claimed feature of transmitting a commercial to the user location reads on the disclosure of Inoue of downloading trailers or previews to the subscriber; col. 9, lines 31-40.

Considering claims 21 & 22, the claimed features correspond with subject matter mentioned above in the rejection of claims 1 & 9, and are likewise treated.

Considering claim 25, the claimed subject matter is also met by the combination of Proehl & Inoue.

Considering claim 27, the claimed, '*plurality of portions*' on a '*second and third channel*' is met by Inoue, col. 6, lines 35-67 thru col. 7, lines 1-30; col. 9, lines 11-22.

Considering claim 28, the combination of Proehl & Inoue plays the lead-in segment, and then the remaining program, which meets the claimed subject matter.

Considering claim 29, Inoue teaches that the first portion may be transmitted on a different channel from the NVOD channels, col. 8, lines 48-65.

Considering claim 30, the claimed features correspond directly with subject matter mentioned above in the rejection of claims 1, 3, 9 & 24, and are likewise treated.

As for the amended feature if storing one of the second sets, Inoue teaches that portions may be stored simultaneous with the delivery of the NVOD program in order to playback during a pause, col. 6, lines 12-67

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Any response to this action should be mailed to:

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or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F(8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Reuben M. Brown/
Patent Examiner, Art Unit 2424